

REMARKS

This Amendment is responsive to the Office Action dated August 12, 2004. Claims 1-18 were pending in the application. In the Office Action, claims 1-18 were rejected. In this Amendment, claims 1 and 10 have been amended, and claim 19 is newly added. Claims 1-19 thus remain for consideration.

Applicants submit that claims 1-19 are in condition for allowance and request reconsideration and withdrawal of the rejections in light of the following remarks.

Double Patenting

Claims 1, 2, 10 and 11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,363,114.

As noted by the Examiner, a timely filed terminal disclaimer may be used to overcome the provisional double patenting rejections provided the conflicting application and/or patent is shown to be commonly owned with the present application.

It is not clear if claims 1, 2, 10 and 11 of the present application as amended are obvious in view of claim 1 of U.S. Patent No. 6,363,114. Hence, Applicants will consider the filing of a Terminal Disclaimer if amended claims 1, 2, 10 and 11 of the present application as amended are obvious in view of U.S. Patent No. 6,363,114.

§102 and §103 Rejections

Claims 1 and 10 were rejected under 35 U.S.C. §102(e) as being anticipated by Boice (U.S. Patent No. 5,978,029).

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boise.

Claims 4-9 and 12-18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully submit that the independent claims (claims 1 and 10) are patentable over Boice.

Applicants' invention as recited in the independent claims is directed toward a video signal coding method and video signal encoder. Each of the claims recites "measuring visual characteristics of the input video signal." Supporting disclosure can be found in the specification at, for example, page 18, lines 8-17.

Since, Boice does not disclose "measuring visual characteristics of the input video signal," Applicants believe that claims 1 and 10 are patentable over Boice.

Furthermore, since dependent claims inherit the limitations of their base claims, dependent claims 2-9 and 11-18 are believed to be patentable over Boice for at least the same reasons discussed in connection with the independent claims 1 and 10.

Applicants submit that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112. Rather,

these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

If any issues remain, or if the Examiner has any further suggestions, he/she is invited to call the undersigned at the telephone number provided below.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

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